REMARKS

Applicant wishes to thank the Examiner for the indication that the present application contains allowable subject matter. Specifically, dependent claim 17 was deemed allowable if rewritten in independent form. Applicant is hopeful that the other claims will also be deemed allowable upon consideration of the present paper.

Claims 1-48 were pending in the Office Action, and these claims remain pending upon entry of this paper. These claims were treated in the Office Action as follows:

- Claims 1-16, 18-35, 38 and 45-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over an alleged combination of JP 11088672 (hereinafter, "Takemura") and Frederick M. Weinhaus, Venkat Devarajan "Texture mapping 3D models of real-world scenes", December 1997, ACM Computing Surveys (CSUR), Vol. 29, Issue 4 (hereinafter, "Frederick")
- Claims 36-37 were rejected under 35 U.S.C. 103(A) as being unpatentable over an alleged three-way combination of Takemura, Frederick and U.S. Patent No. 5,821,523 (hereinafter, "Bunte et al.")
- Claims 39-41 were rejected under 35 U.S.C. 103(A) as being unpatentable over an alleged three-way combination of Takemura, Frederick and Ken Hinckley, Jeff Pierce, Mike Sinclair, Eric Horvitz, "Sensing techniques for mobile interaction", November 2000, proceedings of the 13th annual ACM symposium on User Interface software and technology (hereinafter, "Hinckley")

- Claims 42-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over an alleged three-way combination of Takemura, Frederick and U.S. Patent No. 6,606,117 (hereinafter, "Windle")
- Claim 23 was also rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Copy of Takemura

As noted in the prior amendment, Applicant does not possess an English language translation of the Takemura reference, and requests that the Examiner supply a copy of this reference pursuant to MPEP 707.05(a). Applicant discusses Takemura using what appears to be its corresponding U.S. patent – 6,657,658.

The Alleged Combination of Takemura and Frederick is Improper

A combination of references is only proper if there is a teaching, suggestion, or motivation for making the alleged combination. MPEP 2143. In other words, there must be a reason why someone of ordinary skill would have thought to make the combination. That reason has to come from the prior art; it cannot come from Applicant's disclosure. See, e.g., In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious."); and MPEP 2143.01 ("The Prior Art Must Suggest the Desirability of the Claimed Invention"). Without such a motivation, a combination of references is improper, even if the references separately teach every element of the claimed invention. See, e.g., In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The

combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

Here, there is no reason why someone of ordinary skill would think to make the combination that the Office Action made. The primary reference, Takemura, describes a system in which a consumer takes a picture with a digital camera and sends the image to a remote site for processing. The Takemura consumer sends, along with the picture, finish information that identifies how the picture is to be processed. For example, the finish information can specify "portrait" or "landscape" formatting, or request red-eye reduction. See, e.g., Takemura (U.S.) Fig. 5. The remote site takes the finish information and processes the image as requested.

The Office Action concedes that Takemura fails to teach or suggest the claimed "displaying, after said receiving and generating, the image without said visual effect on the display," from claim 1. To address this deficiency, the Office Action alleges that one of ordinary skill would have thought to apply the Figure 8 technique from Frederick to Takemura's system. However, Frederick relates to a completely different concept, and a completely different technical field, from Takemura. While Takemura deals with finishing and printing photographs for consumers, Frederick deals with texture-mapping computer-generated models. In the cited Figure 8 example, image (c) shows a wireframe 3-D model of a scene, while image (d) shows the same model with texture mapping. Takemura does not deal with computer-simulated images, and would have no need for the wireframe or texture mapping used in Frederick. There is no need, and no reason,

why someone of ordinary skill would add the cited Frederick feature to the Takemura system in the manner alleged. Absent such a need, the alleged combination is improper.

The Combination Fails to Teach or Suggest All Recited Features

Even assuming that the alleged combination was proper, the resulting combination still fails to teach or suggest all recited features. For example, the feature that the Office Action admits is missing from Takemura (the second recited "displaying") is also missing from Frederick. In the Frederick system, the end result of the texture mapping process is the image shown in Figure 8(d). If the texture mapping process were used in Takemura, then the final image displayed would include the texture mapping. There would still be no teaching or suggestion of the two features of "displaying, after said receiving and generating, a version of said image with said visual effect on a display of the user equipment" and "displaying, after said receiving and generating, a version of said image without said visual effect on a display of the user equipment," as recited in independent claim 1. Instead, both Takemura and Frederick display the resulting image with the alleged visual effect (the finishing in Takemura, or the texture mapping in Frederick). Independent claims 41 and 46 similarly recite two "displaying" features with and without the visual effect, and are distinguishable for at least the same reasons as independent claim 1.

Similarly, independent claim 42 recites "display of the image and a version of the image comprising the visual effect on the display;" while claim 45 recites "a display means for displaying the image based on the received image data, said second user equipment being also adapted to display an altered version of the image, wherein the

altered version comprises a visual effect generated based on said additional information associated with the image."

For at least the reasons set forth above, independent claims 1, 42, 45 and 46 distinguish over the applied references. The remaining claims depend from one of these independent claims, and are distinguishable for at least the same reasons as their base independent claims, and further in view of the features recited therein. For example, claim 2 recites "wherein said version of the image associated with the visual effect is presented before said step of displaying the image without said visual effect." The Office Action alleges that Frederick displays a version with the visual effect before displaying the image without the visual effect, but there is no teaching or suggestion in Frederick of displaying the texture-mapped image before displaying the image without the texture mapping.

As another example, claim 7 recites "wherein the visual effect visualizes the age of the image." The Office Action continues to cite the "setting sun finish" and "snow finish" from the Takemura reference. Applicant noted in the prior amendment that those finishes from Takemura refer to the "color and brightness" numerical settings that the laboratory 2 will use to develop the picture, and have nothing to do with the age of the image. Col. 8, lines 19-22. The Office Action does not respond to this point, and Applicant requests a response if the rejection is to be maintained. For example, if an image has color values of a setting sun finish, how old is the picture? That finish has nothing to do with the image's age.

As another example, claim 11 recites "wherein the visual effect visualizes relative location between the source of the image and the user equipment." The Office Action

contends that the Frederick Fig. 8 texture mapping teaches such a feature. The texture mapping has nothing to do with the relative location between the source of the image and the user equipment. Indeed, the texture-mapped image would be the same regardless of where it was being viewed.

As another example, the Office Action rejects claims 23-25 by simply asserting the following:

> 15. Claims 23-25, it's obvious to use the visual effect as an audio.

That is the entire discussion of this ground of rejection. A rejection on the grounds of obviousness needs proof. Here, the Office Action cites none.

As another example, claim 36 recites "wherein the presentation of the visual effect comprises provision of a shaking or vibrating version of the image." In Applicant's prior response, Applicant pointed out that the Bunte et al. reference regards shaking as a defect in taking a picture. The Office Action offers no explanation for why one of ordinary skill would seek to add this defect by shaking the texture-mapped image in Frederick. If this rejection is to be maintained, Applicant requests a response on this issue.

The Rejection Under 35 U.S.C. 112, Second Paragraph

The Office Action also rejects claim 23 for being indefinite. Applicant submits that the claim is perfectly clear, and no one of ordinary skill would have trouble understanding its scope. An audio effect can be visualized in any number of ways, and the mere fact that a claim may be broad does not render it indefinite. See, e.g., MPEP 2173.04 ("Breadth is Not Indefiniteness").

Conclusion

For at least the foregoing reasons, the pending claims are believed to distinguish over the applied references. If, however, the Examiner feels that additional discussion and/or amendment would be helpful, the Examiner is invited to telephone the Applicants' undersigned representative at the number appearing below.

Respectfully submitted,

Date: February 28, 2007

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